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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,675	06/07/2001	Ralf Fischer	1594	9966
7590	03/26/2004		EXAMINER	
Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743			TORRES, MARCOS L	
			ART UNIT	PAPER NUMBER
			2683	
DATE MAILED: 03/26/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/857,675	FISCHER ET AL.
	Examiner	Art Unit
	Marcos L Torres	2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 37-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 37-49 and 51-70 is/are rejected.
- 7) Claim(s) 50 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 53 is objected to because of the following informalities: it is unclear if the short message is transmitted from mobile station or the central station. Appropriate correction is required.
2. Claims 46-70 are objected to because of the following informalities: the claims are hybrid claims, the independent claim is a message and the dependent claims are method, it is unclear if it is message or method type of claims. Appropriate correction is required.
3. Claim 56 is objected to because of the following informalities: it is unclear what part of the claim is pertaining to a network operator or service provider. Appropriate correction is required.
4. Claim 55 is objected to because of the following informalities: a dependent claim cannot depend on it self. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claim 58 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification do not disclose the transcriber.

7. Claim 61 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim disclose the term "power scope", it is unclear from the specification what this term means.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. The claims 48, 53, 56, 58 and 69 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

#### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 37-38, 41-42, 44 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Alanara.

As to claim 37-38 and 49, Alanara discloses a message for transmitting short messages in a radio telecommunications network, comprising the steps of sending a

notice to a subscriber of a telecommunications network as a function of a short message transmitted to the telecommunications network for the subscriber (see col. 1, lines 6-17); transmitting to the subscriber with the notice, data that includes items of information about a content of the short message; and transmitting to the subscriber as the notice, a first data field of the short message, which includes the data having the items of information about the content of the short message (see col. 2, lines 1-8).

As to claim 41, Alanara discloses a message further comprising transmitting to the subscriber the items of information about the makeup of the short message about a size of the data fields (see col. 2, lines 4-8).

As to claim 42, Alanara discloses a message further comprising transmitting to the subscriber the items of information about the content of the short message, indications about presence of various data types and the short message in various data fields of the short message (see col. 2, lines 4-9).

As to claim 44, Alanara discloses a message further comprising reading out at the subscriber the items of information about the makeup and/or content of the short message from a notice received and shown on a display device (see col. 2, lines 15-23).

As to claim 47, Alanara discloses a method further comprising processing the items of information about the content of the short message in a subscriber station of the subscriber (see col. 3, lines 45-52).

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 39-40, 45-46, 52-62, 66-68 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara in view of Vanttila.

As to claim 39, Alanara discloses everything claimed as explained above except for the message transmitting to the subscriber the notice only after a request signal has

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been output by the subscriber to the telecommunications network. Vanttila discloses a message further comprising transmitting to the subscriber the notice only after a request signal has been output by the subscriber to the telecommunications network (see col. 6, lines 5-35). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Alanara message for the simple purpose of managing bandwidth.

As to claim 40, Alanara discloses everything claimed as explained above except for a message further comprising providing the first data field of the short message as a text-based data field. Vanttila discloses a message further comprising providing the first data field of the short message as a text-based data field (see col. 5, lines 16-19). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Alanara message for a friendly user system.

As to claims 45 and 46, Alanara discloses a message further comprising transmitting to the subscriber the items of information about the content of the short message (see col. 2, lines 1-8). Alanara does not specifically disclose the data in menu/directory-controlled fashion, corresponding menu structures being generated at the subscriber as a function of the readout information about the makeup and/or content of the short message. Vanttila disclose the data in menu/directory-controlled fashion, corresponding menu structures being generated at the subscriber as a function of the readout information about the makeup and/or content of the short message (see col. 6, lines 13-20). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique for a user-friendly interface.

As to claim 52, Alanara discloses a method further comprising transmitting the notice to the subscriber in form of a short message (see col. 1, lines 6-15). Alanara does not specifically disclose transmitting the global system for mobile communications standard. However, OFFICIAL NOTICE IS TAKEN THAT GSM standard is a common and well-known standard. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this standard or any other equivalent standard for the simple purpose of compatibility.

As to claims 53 and 66-68, Alanara discloses everything claimed as explained above except for a method further comprising transmitting the short message to the telecommunications network by a sender, from a mobile sending station. Vanttila discloses a method further comprising transmitting the short message to the telecommunications network by a sender, from a mobile sending station (see col. 6, lines 13-15). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching for the simple purpose of sending a command.

As to claims 54 and 55, Alanara discloses everything claimed as explained above except for a method further comprising transmitting from the central station to the telecommunications network an acknowledgment message for the sender, once the short message has been received from the central station. However, OFFICIAL NOTICE IS TAKEN THAT the method of sending acknowledgment once the step have been completed is a common and well-known technique. Therefore, it would have been

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obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple purpose of reliability.

As to claim 56 is a combination of limitations of claims 52 and 55. Therefore they are rejected for the same reason of claims 52 and 55.

As to claim 57, Alanara discloses everything claimed as explained above except for a method further comprising transmitting the short message from a central station, which is a network operator for a receiver, which is mobile receiver to the telecommunications network. Vanttila discloses a method further comprising transmitting the short message from a central station, which is a network operator for a receiver, which is mobile receiver to the telecommunications network (see col. 6, lines 34-35). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique in order to receive messages.

As to claim 58, Alanara discloses everything claimed as explained above except for a method further comprising processing by a command message transmitting to the telecommunications network at least one data field of the short message. Vanttila discloses a method further comprising processing by a command message transmitting to the telecommunications network at least one data field of the short message (see col. 5, lines 25-50; col. 6, lines 25-32). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the Alanara message for enhanced user control.

As to claim 59, Alanara discloses everything claimed as explained above except for a method further comprising preparing the command message at the subscriber as a

function of at least one user input at an input unit. Vanttila discloses a method further comprising preparing the command message at the subscriber as a function of at least one user input at an input unit (see col. 6, lines 13-24). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique for enhanced user versatility.

As to claim 60, Alanara discloses everything claimed as explained above except for a method further comprising preparing the command message automatically at the subscriber at the function of the items of information about the content of the short message. Vanttila discloses a method further comprising preparing the command message automatically at the subscriber at the function of the items of information about the content of the short message (see col. 6, lines 13-24). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature to the Alanara message for easier use.

As to claim 61, Alanara discloses everything claimed as explained above except for a method further comprising preparing the command message as a function of command criteria that are specified by the subscriber. Vanttila discloses a method further comprising preparing the command message as a function of command criteria that are specified by the subscriber (see col. 6, lines 13-24). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature for enhanced control of services.

As to claim 62, Alanara discloses everything claimed as explained above except for a method further comprising requesting by the subscriber from the

telecommunications network at least one data field of the short message by means of a command message embodied as a selection message and transmitted to the telecommunications network; and transmitting the at least one requested data field of the short message to the subscriber. Vanttila discloses a method further comprising requesting by the subscriber from the telecommunications network at least one data field of the short message by means of a command message embodied as a selection message and transmitted to the telecommunications network; and transmitting the at least one requested data field of the short message to the subscriber (see col. 6, lines 13-40). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature for enhanced control of services.

As to claim 70, Alanara discloses a notice in form of a header information; and further comprising generating from indications about the content of at least two data fields of the short message the items of information about the content of the short message; and obtaining the indications from these data fields (see col. 2, lines 1-23). Vanttila discloses a method further comprising transmitting from the central station to the telecommunication network the command message in form of a short message service message (see col. 3, lines 52-55; col. 6, line 13-40) by a global system for mobile communications standard, and the notice in form of a first item of header information; and further comprising generating from indications about the content of at least two data fields of the short message the items of information about the content of the short message; and obtaining the indications from these data fields. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the

invention to add this teaching to the Alanara message for the simple purpose of enhanced service.

16. Claims 43 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara in view of Winbladh.

As to claim 51, Alanara discloses everything claimed as explained above except for a method further comprising transmitting to the communication network the short message as a message from an electronic mail surface as an Internet E mail message. Winbladh discloses a method further comprising transmitting to the communication network the short message as a message from an electronic mail surface as an Internet E mail message (see abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature to the Alanara system for versatility.

As to claim 43, Alanara discloses a message further comprising transmitting to the subscriber the items of information about the content of the short message (see col. 2, lines 1-8). Alanara does not specifically disclose indications about the sender of the data stored in memory of the short message. Winbladh discloses indications about the sender of the data stored in memory of the short message (see col. 7, lines 6-23). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Alanara message for enhanced convenience.

17. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara in view of Söderbacka.

As to claim 48, Alanara discloses everything claimed as explained above except for a method further comprising transmitting the items of information about the content of the short message for processing to an identity module of the subscriber. Söderbacka discloses a method further comprising transmitting the items of information about the content of the short message for processing to an identity module of the subscriber (see col. 4, line 29 – col. 5, line 14). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the Alanara message for enhanced control.

18. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara in view of Vanttila as applied to claims 39-40, 45-46, 52-62, 66-68 and 70 above, and further in view of Söderbacka.

As to claim 65, Alanara discloses everything claimed as explained above except for a method further comprising transmitting by the subscriber to the telecommunications network a command message embodied as a delete message; and deleting at least one data field of the short message as a function of the delete message. Söderbacka a method further comprising transmitting by the subscriber to the telecommunications network a command message embodied as a delete message; and deleting at least one data field of the short message as a function of the delete message (see col. 6, lines 10-50). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the Alanara message for enhanced control.

19. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara in view of Vanttila as applied to claims 39-40, 45-46, 52-62, 66-68 and 70 above, and further in view of Proust.

As to claim 69, Alanara discloses everything claimed as explained above except for a method further comprising preparing the command message and the notice by an identity module of the subscriber, which pertains to a service provider. Vanttila discloses a method further comprising preparing a command message, which pertains to a service provider (see col. 6, lines 13-24). Proust discloses a method further comprising preparing a notice by an identity module of the subscriber, which pertains to a service provider (see col. 2, lines 12-17). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching for the simple purpose of having enhanced services.

20. Claims 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara in view of Vanttila as applied to claims 39-40, 45-46, 52-62, 66-68 and 70 above, and further in view of Hansson.

As to claims 63 and 64, Alanara discloses a method further comprising transmitting at least two data fields of the short message sequentially (see col. 2, lines 1-8). Alanara does not specifically disclose that are requested by the subscriber by the selection message, simultaneously transmitted. Hansson discloses transmitting simultaneously (see col. 1, lines 37-40). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching for bandwidth management purpose.

***Allowable Subject Matter***

21. Claim 50 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

22. The following is a statement of reasons for the indication of allowable subject matter:

A method further comprising transmitting to the subscriber a second item of header information and user data, the first item of header information including an item of information about the presence of the second item of header information, and the second item of header information including at least one item of information about the type of evaluation of the notice to be performed.

***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Ritter U.S. Patent US006543686B1

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- b. Rogers U.S. Patent US006301484B1
- c. Blants U.S. Patent US006529717B1
- d. Suprunov U.S. Patent US006405030B1
- e. Laumen PCT WO 01/45320 A2

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L Torres whose telephone number is 703-305-1478. The examiner can normally be reached on 8:00am-5:30pm alt. friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marcos L Torres  
Examiner  
Art Unit 2683

Mlt



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